

RESTRICTION REQUIREMENT

Restriction to one of the following inventions is required under 35 U.S.C. 121 and 372:

- I Claims 1-3 and 5-8, to the extent that they are drawn to a polypeptide comprising an amino acid sequence at least 95% identical to the amino acid sequence of SEQ ID NO: 1.
- II Claims 1, 5 and 7, to the extent that they are drawn to a polypeptide comprising an amino acid sequence at least 95% identical to the amino acid sequence of SEQ ID NO: 5.
- III Claims 1, 2, and 4-8, to the extent that they are drawn to a polypeptide comprising the amino acid sequence of SEQ ID NO: 3.
- IV Claims 9 and 10, to the extent that they are drawn to a polynucleotide encoding a polypeptide comprising the amino acid sequence of SEQ ID NO: 1.
- V Claims 9 and 10, to the extent that they are drawn to a polynucleotide encoding a polypeptide comprising the amino acid sequence of SEQ ID NO: 3.
- VI Claims 9 and 10, to the extent that they are drawn to a polynucleotide encoding a polypeptide comprising the amino acid sequence of SEQ ID NO: 5.
- VII Claim 11, to the extent that it is drawn to an antibody that binds a polypeptide comprising the amino acid sequence of SEQ ID NO: 1.
- VIII Claim 11, to the extent that it is drawn to an antibody that binds a polypeptide comprising the amino acid sequence of SEQ ID NO: 3.
- IX Claim 11, to the extent that it is drawn to an antibody that binds a polypeptide comprising the amino acid sequence of SEQ ID NO: 5.

ELECTION

In response to the Restriction Requirement mailed September 23, 2003, Applicant elects the invention of Group I (claims 1-3 and 5-8 to the extent they are drawn to a polypeptide comprising

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an amino acid sequence at least 95% identical to the amino acid sequence of SEQ ID NO:1), with traverse.

For the reasons set forth below, Applicant submits that the restriction requirement is improper, and should be withdrawn, whereby an action on the merits of all of the pending claims is warranted.

TRAVERSE

Notwithstanding the election of the claims of Group I in order to be responsive to the requirement for restriction, Applicant respectfully traverses the requirement.

The Examiner is reminded that in determining unity of invention, the criteria set forth in 37 C.F.R. § 1.475 must be considered. Specifically, § 1.475(a) sets forth the definition of the requirement for unity of invention, and the unity of invention that must be satisfied, where a group of inventions is claimed, in order to have the right to include multiple inventions in a single application. In particular, § 1.475(a) states that a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

In this regard, it is stated that:

Where a group of inventions is claimed in an application, the requirement for unity of invention shall be fulfilled only when there is technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole makes over the prior art.

Further, § 1.475(b) defines several combinations of different categories of claims which always fulfill the unity of invention requirements of § 1.475(a) where the same or corresponding

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special technical features is claimed. Thus, the requirement for unity of invention is fulfilled when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. In the instant situation, the claimed sequences can be considered to be analogous to claims directed to a process specially adapted for the manufacture of the claimed polypeptide of Groups I, II and III.

Thus, the presently pending claims have unity of invention, whereby the instant restriction requirement is improper, and should be withdrawn.

Still further, the requirement asserts that claim 1 may lack patentability over the prior art. However, the requirement does not indicate how claim 1 is considered to be anticipated or obvious over JP 6-25925 A, JP 9-65885 and JP 8-325293. The Restriction Requirement appears to assert that because the International Search Report indicates that the claimed invention is not novel, unpatentability has been proven, and the claimed inventions lack unity of invention. However, Applicant notes that the Examiner may not simply rely on an International Search Report to prove unpatentability, but the Examiner bears the burden of proving unpatentability under U.S. Patent law. The Restriction Requirement fails to bear the burden of proving unpatentability, and, accordingly, the assertions contained therein are without appropriate basis, and the restriction should be withdrawn.

Finally, restriction cannot be proper in such an instance as there is no undue burden to examiner each of Applicant's claims. Reference is made to M.P.E.P. 803 which indicates that restriction should not be required where there is not undue burden for the Examiner to examine each of Applicants' claims. In the current case, the Examiner has not pointed to any evidence of a serious